UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,192	06/25/2003	Bradley R. Wolf	633032-002	4246

7590 04/20/2006

MARK P. LEVY, ESQ.
THOMPSON HINE, LLP
2000 COURTHOUSE PLAZA NE
10 W. SECOND STREET
DAYTON, OH 45402-1758

EXAMINER	
ADAMS, AMANDA S	

ART UNIT	PAPER NUMBER
3731	

DATE MAILED: 04/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/606,192	WOLF ET AL.	
	Examiner	Art Unit	
	Amanda Adams	3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on *25 June 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-16* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date ~~25 June 2003~~. 11/13/03 ASA
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 2-7 and 9-10 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 9-14 and 16-17 of copending Application No. 10/606191 (for which a Notice of Allowance was mailed on April 7, 2006). Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of 10/606192 are slightly broader than the claims of 10/606191. The structural limitations set forth in claims 2-7 and 9-10 of the instant application are also claimed in application 10/606191, e.g., the composition of the braided thread including the number of gold and bioabsorbable threads, the

thickness of the suture, attachment of the suture to different types of needles, and the angle of the braid of the suture.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Objections

1. Claim 14 is objected to because of the following informalities: Incorrect grammar in the claim. Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 3, and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Horton (US 5,645,558).

4. As to claims 1 and 7, Horton discloses a biocompatible fibrous braid that can be used as a suturing thread, that is made of strands of gold (column 4, line 15) and either polyglycolic acid, which is a bioabsorbable polymer, or silk, which is bioabsorbable but not a polymer (column 4, lines 56-67).

5. As to claim 3, Horton discloses a braided material suitable for suturing in which the range of number of threads in the braid overlaps the range of 3-9 threads as claimed by the applicant (column 5, line 2).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 2, 4-6, and 8-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horton (US 5,645,558) in view of Adamyan et al (US 6,086,578).

8. As to claims 2, 4-6, 8, and 10, Horton discloses the invention substantially as claimed except for failure to disclose particular thread counts, gold and bioabsorbable thread ratios, and the gauge range for the diameter of the braided suturing material. These are all obvious design choices in prior biocompatible gold and gold alloy threads. Furthermore, the specification lacks criticality as to why these particular details provide any specific advantage over the prior art.

9. As to claim 9, Horton discloses the invention substantially as claimed except for attaching the suture material to a needle. However, Adamyan et al teach that the threads, both the gold and the bioabsorbable material, are attached to a needle (column 1, line 67). They teach that it is attached to an ordinary needle, and then further specify a special needle design (column 2, lines 34-37). Therefore it would have been obvious that this suture composite is attachable to a multitude of needle types.

10. As to claims 11-16, Horton discloses the invention substantially as claimed except for failing to disclose a method of skin lifting with the braided material, where it is implanted intradermally.

However, Adamyan et al teach a braided gold thread and a bioabsorbable thread inserted with the same needle and used specifically for intradermal suturing (column 1, lines 64-67). Further, Adamyan et al teach that these sutures are made in specific skin fold areas where traction and tightening of the skin is desired in order to reduce the appearance of wrinkles (column 2, lines 13-27).

Therefore, it would have been obvious to include the bioabsorbable polyglycol thread in the braided structure of the braided gold thread, to create a braided suturing material as that disclosed by Horton, because in the material of Adamyan et al, both suturing materials are already attached to the same needle. This would allow easier use by the surgeon when preparing the suture and needle and reduce complications when suturing.

11. As to claim 15, a suture that is ultra thin is already old and well-known in the art, and any suturing thread that can be implanted intradermally without being seen from the outside of the patient's skin can be considered ultra thin.

12. As to claim 16, it is old and well known in the art, that when stitching or suturing, the length of the stitch is shorter than the length of the needle.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amanda Adams whose telephone number is (571) 272-5577. The examiner can normally be reached on M-F, 8:00am-5:00pm, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan Nguyen can be reached on (571) 272-4963. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ASA ASA 4/17/06

ANHTUAN T. NGUYEN
SUPERVISORY PATENT EXAMINER
4/17/06.